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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,779	07/27/2001	Ronald J. Skrzyniarz	1945.BDM	8792

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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action**Application No.**

09/916,779

Applicant(s)

SKRZYNIARZ ET AL.

Examiner

Victor S Chang

Art Unit

1771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 12-18, 21 and 22.

Claim(s) withdrawn from consideration: 19 and 20.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1869

1700

Daniel Zinker

NOTE

1. It should be noted that proposed amendments to claims not compliant with the revised amendment practice 37 CFR 1.121. In particular, cancelled claims 1-11 should be listed and clearly marked with expression "(cancelled)". Additionally, it is noted that previously cancelled claims are also improperly presented on pages 7-8. Appropriate correction and deletion are required.
2. While the proposed amendments to claims 12, 17, and 21 overcome the rejection over 35 U.S.C. 112, second paragraph (see Office action dated 6/13/2003), the Examiner notes that the proposed amendment to claim 13 is still insufficient. The Examiner repeats (see Paper No. 5, page 2) that the standard of the "volume" is absent from the claim recitation. As such, the amendments are not entered, because they are not deemed to place the application in better form for appeal.
3. The Examiner notes that Applicants' remarks contending that "The two polyvinyl acetate resins ... have different Tgs, etc. (Remarks, page 4, first paragraph) appears erroneous, because it is common knowledge that the Tg (glass transition temperature) of a homopolymer is essentially a constant property.
4. Applicants' argument that "Murphy ... does not teach countertops or any other article wherein a wood composite material is bonded to a high pressure laminate using a foamed adhesive comprising polyvinyl acetate" has been carefully considered, but is not persuasive. The Examiner repeats (see Paper No. 5, page) that Murphy expressly teaches that it is known art to form an article by bonding a surface covering material on

a substrate such as a floor surface, wall surface, countertop, etc. (column 1, lines 16-18). Murphy also teaches that particularly suitable adhesives including polyvinyl acetate latex, etc. may be utilized (column 3, lines 51-68). It should be noted that the surface covering material and the substrate (in particular a countertop) inherently encompass the high pressure laminate and wood composite, respectively, of the instant claimed invention, as evidenced in the Specification (page 1, second paragraph). It should be noted that while Murphy uses vinyl acetate butyl acrylate copolymer in exemplified formulations, nowhere Murphy teaches that they are limiting examples.

5. With respect to Applicants' argument that "Articles of the type claimed by applicants are not manufactured in the field, but are mass produced in a factory ..." (Remarks, page 5, bottom paragraph), the Examiner notes that the aforementioned process environment is absent from any of the claims; further, it should be noted that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art.